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June 28, 2005

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant: Jim Sowerwine
Serial No.: 09/683,595
Filing Date: 01/23/2002
For: Golf Swing Practice Device
Our Reference: 1370.01

Examiner: Alvin A. Hunter
Art Unit: 3711
Confirmation No.: 6408

Dear Sir:

Enclosed please find the following:

1. Brief of Appellant, in triplicate, having a Certificate of Mailing dated June 28, 2005;
2. Check No. 0947 \$250.00 to cover the filing fee for said Brief of Appellant.
3. Self-addressed, postage prepaid post card to serve as a receipt for items 1 and 2.

Very respectfully,

SMITH & HOPEN

By: Ronald E. Smith
ron.smith@smithhopen.com

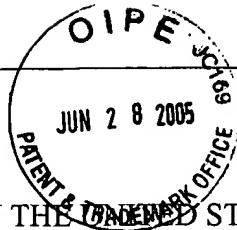
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Enclosures
pc: Mr. Jim Sowerwine

CERTIFICATE OF MAILING
(37 C.F.R. 1.10)

I HEREBY CERTIFY that this Brief of Appellant, in triplicate, and fee, is being deposited with the United States Postal Service in an envelope as "Express Mail Post Office to Addressee," mailing Label No. EV624410134US, addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 28, 2005.

Date: June 28, 2005

Deborah Preza



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

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BRIEF OF APPELLANT

1. Real Party In Interest.

Applicant is the real party in interest.

2. Related appeals and interferences.

There are no related appeals or interferences directly affecting or that will be directly affected or that would have a bearing on the Board's decision in this appeal.

3. Status of claims.

Claims 1-13 were initially filed and later canceled. Claims 14-21 are pending.

4. Status of amendments.

Amendment F was filed and entered 12/21/2004.

More particularly, claims 1-13 were initially filed. Claims 1, 7, 10 and 13 were amended a first time and claim 11 was cancelled in Amendment A filed 01/17/2003. A telephone interview between Applicant's attorney and the examiner in charge of the application was held on 03/03/2003 but no agreement was reached. Claims 1 and 13 were amended a second time, and claims 3-6 and 9 were amended a first time in Amendment B, filed but not entered on 04/02/2003. A second telephonic interview was held 04/02/2003 but did not result in an agreement. A Request for Continued Examination and a Preliminary Amendment were filed 05/21/2003 and the Preliminary Amendment was not entered because it omitted a sheet containing mark-ups showing the changes made. Claims 1-13 were cancelled and new claims

14-21 were filed in a Preliminary Amendment filed and entered 07/23/2003 upon acceptance of the Request For Continued Examination. Claims 14-19 and 21 were amended a first time in Amendment D (treating the Preliminary Amendment as the third or "C" amendment) on 10/17/2003. Claims 14-19 and 21 were amended a second time and claim 20 a first time in Amendment E filed 03/29/2004. Claims 14 and 15 were amended a third time in Amendment F filed and entered 12/21/2004. A final rejection of claims 14-21 was mailed 05/16/2005 and a Notice of Appeal of claims 14-21 was filed 05/31/2005.

5. Summary of invention.

Citations to the specification are by page and paragraph number.

Paragraphs [0017], [0018], and [0019] were deleted by the Preliminary Amendment filed 07/23/2003 and eleven (11) unnumbered paragraphs were substituted therefore. All eleven (11) of said paragraphs were amended in Amendment D filed 10/17/2003. Said eleven (11) paragraphs appear on pages 2 and 3 of said Amendment D and the summary of the invention is taken in part from those pages.

The golf practice device helps a golfer develop an optimal golf swing. It includes a base adapted to overlie a ground surface. [0035] A vertical extension 80 is mounted to the base in upstanding relation relative to the ground surface. [0035] A horizontal extension 60 is secured to an upper end of vertical extension 80 in cantilevered relation thereto. [0035] Horizontal extension 60 is disposed in a substantially horizontal plane at a substantially right angle to a line 130 that extends from a target golf hole to a stationary golf ball supported by the ground surface. (Page 2 of Amendment D, first unnumbered paragraph)

A free end of horizontal extension 60 is disposed in vertically spaced apart relation to the ground surface and the free end is disposed substantially directly above the stationary golf ball. ((Page 2 of Amendment D, second unnumbered paragraph)

Cradle interface 50 is secured to the free end of horizontal extension 60. (Page 2 of Amendment D, third unnumbered paragraph)

A support arm is adapted to be releasably engaged by the cradle interface. (Page 2 of Amendment D, fourth unnumbered paragraph). The support arm, when releasably engaged by the cradle interface, is disposed substantially horizontally and is disposed substantially parallel to the line that extends from the target golf hole to the stationary golf ball. *Id.*

Support arm 30 is at least partially covered by a soft foam material 20. [0035] and page 2 of Amendment D, fifth unnumbered paragraph

The releasable engagement of support arm 30 by cradle interface 50 enables support arm 30 to separate from cradle interface 50 if the soft foam material 20 is struck by the golf club. [0035] and page 2 of Amendment D, sixth unnumbered paragraph)

Support arm 30 has a first position where it is disposed in trailing relation to cradle interface 50 and in parallel relation to the line that extends from the target golf hole to the stationary golf ball. [0036]. Support arm 30 has a second position where it is disposed in leading relation to the cradle interface and in parallel relation to the line that extends from the target golf hole to the stationary golf ball. [0037]. Support arm 30 is in the first position when a student golfer uses the device [0036] and the support arm is in the second position when an advanced golfer uses the device. [0037].

The first and second positions of support arm 30 are mutually exclusive of one another because the support arm when in the first position is not positionable in the second position and when in the second position is not positionable in the first position. (Inherent in the structure because support arm 30 cannot be in two places at the same time).

The releasable engagement of support arm 30 by cradle interface 50 enables a golfer to re-configure support arm 30 relative to cradle interface 50 to selectively position support arm 30 in the first or second position so that golfers having differing skill levels may practice their golf swing by using the device.

6. Issues.

Whether the Office erred in rejecting claims 1 and 4 under 35 U.S.C § 103(a) as being unpatentable over Williams in view of White and Gidney.

7. Grouping of claims.

The claims on appeal stand or fall together; claim 14 is the only independent claim.

8. Argument.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Marier, Jr. in view of Wateska et al. (hereinafter "Wateska").

The Office contends: "Though Marier, Jr. prefers the elevated path guide means to extend in two directions, (it) would achieve the same result with one rod extending in one direction and would be obvious to omitted (*sic*) a rod in order to reduce the arc swing zone of the user."

This contention of the Office is respectfully traversed because both rods are required in the Marier, Jr. construction. If the arc swing zone of the user is reduced by being cut in half, then Marier, Jr. provides no path guidance means. The Marier, Jr. device lacks utility if the leading end of rod assembly 12 is removed or if the trailing end of the rod is removed. Fig. 1 indicates that both rods 22, 22 must be used at the same time and Figs. 2 and 3 indicate that rod assembly 12 must be engaged at its mid-point by T-joint 24.

The teaching of a single rod positioned either on the leading or the trailing side of a T-joint, but not on both sides at the same time, is Applicant's teaching. The Office's contention that the Marier, Jr. construction "would achieve the same result with one rod extending in one direction and would be obvious to omitted a rod in order to reduce the arc swing zone of the user..." should be reconsidered and withdrawn to avoid unfairness to Applicant.

In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) held that omission of parts such as an additional framework or an axle would have been obvious because such omission increased the cargo carrying capacity of a mobile fluid carrying unit. Consistently, *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975), held that it would have been obvious to delete a prior art switch, thereby eliminating its function.

The rationale behind *Larson* and *Kuhle* is that deletion of a part is not an inventive step if the purpose behind the deletion is merely to omit a function. A vehicle without brakes does not represent an improvement over a vehicle with brakes. However, Applicant has not merely deleted one of the Marier, Jr. rods 22 to eliminate one of the functions of the Marier, Jr. device. To the contrary, Applicant has added a support rod that is selectively placed either in leading or

trailing relation to the cradle interface. Marier, Jr., provides no rod that can be positioned either in leading or trailing relation to T-joint 24. The Marier, Jr. rods 22, 22 can only be placed on opposite sides of T-joint 24 at the same time.

In *Larson*, elimination of the extra framework or the axle did not destroy the function of the mobile fluid carrying unit. In *Kuhle*, elimination of an unneeded switch actuator did not destroy the function of the device. In both cases, the purported improvement was a mere deletion of an unnecessary part.

Applicant, on the other hand, has disclosed a structure patentably distinct from the structure of Marier, Jr. Deletion of an unneeded, superfluous part of the Marier, Jr. structure does not produce the structure recited in Applicant's claim 1. Both rods 22, 22 are absolutely required by Marier, Jr. Deletion of either rod 22, 22 destroys the utility of the Marier, Jr. structure. Neither rod 22, 22 can be characterized as a superfluous, unneeded part like the axle in *Larson* or the switch actuator in *Kuhle*.

Accordingly, neither *Larson* nor *Kuhle* apply to the facts of the present case. Applicant has not merely deleted a part or parts from Marier, Jr. to omit a function that is not needed. Applicant has clearly not deleted rod assembly 12 which is formed of rods 22, 22. Omission of either rod 22, 22 renders the Marier, Jr. device non-functional. It would not have been obvious to modify the Marier, Jr. structure to remove all of its functionality.

Larson and *Kuhle* would apply if Applicant had deleted, for example, either one of tubing members 52, 52, because such omission would not affect the operability of the Marier, Jr. device. Both items of tubing 52, 52 could be deleted without affecting the utility of the Marier, Jr. device. However, deletion of either rod 22, 22 is an entirely different matter and does not fall under the *Larson* and *Kuhle* line of cases. Rods 22, 22, as Marier, Jr. points out at col. 2, lines 56-59, can be replaced by a continuous shaft. Therefore, it would not have been obvious to omit either one of them because to do so prevents said rods or continuous shaft from providing the path guidance means of the Marier, Jr. invention.

Marier, Jr., obviously neither teaches nor suggests that rod assembly 12 could be reduced to only one rod 22, or that rod assembly 12 can be mounted entirely on the leading side of T-joint 24 or entirely on the trailing side of said T-joint.

Claim 14 further recites that Applicant's support rod is selectively and manually positionable in either leading or trailing relation to the cradle interface. This emphasizes the point that the Marier, Jr. rods 22,22 cannot be positioned in leading or trailing relation to T-joint 24. To function, the Marier, Jr. rods 22,22 must be positioned simultaneously in leading and trailing relation to T-joint 24.

Rods 22, 22 would no longer provide a path guidance means if either one of them were deleted from the Marier, Jr., construction. Both *Larson* and *Kuhle* hold that eliminating a non-critical part is an obvious expedient not rising to the level of a patentable improvement. Applicant did not merely delete a non-critical part to eliminate a superfluous function. Applicant provided a training device having only one removable part and the device is re-configurable to match the skill level of the user as is claimed with specificity in claim 14. Marier, Jr. is not re-configurable at all and cannot be adapted to players of differing skill levels. Any modification of Marier, Jr. to make it re-configurable for players of differing skill levels would derive from Applicant, and not the other way around. Applicant is therefore entitled to the *quid pro quo* promised those who advance the useful arts.

Applicant concedes that Wateska teaches the use of cushioning material in a golf swing training device but Marier, Jr., modified by Wateska, does not suggest the invention recited in claim 14.

Accordingly, reversal of the final rejection is solicited. A fair interpretation of the prior art does not support the Office's position.

Very respectfully,

SMITH & HOPEN

Date: June 28, 2005

By: 

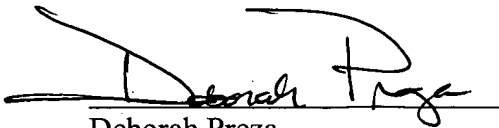
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Dated: June 28, 2005


Deborah Preza

9. Appendix.

1. (Thrice amended) A method for making a chip shot in the game of golf, comprising the steps of:

providing a golf club having an elongate shaft of predetermined elongate extent;

positioning a club head of said golf club and said elongate shaft of said golf club in a substantially vertical plane, said vertical plane being substantially perpendicular to an imaginary line drawn from a target hole to a golf ball;

said predetermined elongate extent being sufficient to adapt said golf club to be maintained in said substantially vertical plane by first and second hands of a golfer standing in a fully erect posture and facing a target golf hole;

positioning a golf ball near a preselected foot of said golfer on an exterior side thereof;

said elongate shaft adapted to be grasped, generally mid-length thereof, from behind by a hand of a substantially straight first arm of said golfer;

an upper end of said elongate shaft adapted to be grasped by a second hand of said golfer having a second arm bent at the elbow and extending across the chest in grasping relation to said upper end in the general vicinity of the shoulder;

swinging the club head away from the target hole by a distance substantially equal to the distance of a back swing when tossing a hand-held golf ball toward said target hole with an underarm toss while facing said target hole;

performing a forward swing of said golf club by swinging the club head toward the target hole with a force substantially equal to a force used when tossing a hand-held golf ball toward said target hole with an underarm toss while facing said target hole;

performing said steps with a golf club having a lofted club head;

performing said steps with a golf club head disposed at a substantially one hundred degree angle relative to said elongate shaft so that a sole of said club head is substantially parallel to the ground at the moment of impact of the club head against the ball and so that said shaft is positioned at an angle of about ten degrees relative to an imaginary line that is perpendicular to a putting surface;

whereby the club head of said golf club passes said preselected foot in closely spaced relation thereto; and

whereby a chip shot is executed by a golfer while standing fully erect and facing a target hole and while swinging the club head with a motion and with a force substantially equal to a motion and force used to perform an underarm toss of a golf ball toward a target hole.

4. (Once amended) The method of claim 1, wherein said lofted club head has a loft substantially equal to the loft of an eight iron.